

Remarks

Claims 1-12, 14-15, and 31-42 are pending for the Examiner's consideration. Claims 1, 7, 8, and 14 have been amended, claims 13 and 16-30 have been canceled, claims 3-5, 10 and 15 have been withdrawn from consideration, and new claims 31-42 have been presented. No new matter is believed to have been added by the amendments presented herein to the specification and claims.

The specification has been amended to correct a typographical error in the date of the claim to priority. No new matter has been added; this amended text is consistent with the date previously presented in the second paragraph of the claim to priority. The specification also has been amended to reflect that the parent Application No. 09/774,874, has issued as U.S. Patent No. 6,655,434 B2, as requested in the Office Action.

Election/Restrictions

The Office Action required restriction between claims 1-14 drawn to a method of closing an open end of a product (Group I) and claim 15 drawn to a panel (Group II). The Office Action states that "[t]he inventions are distinct" and that "[i]n the instant case, the panel could be made by another process where the first layer is not roller [sic.] toward the second layer (i.e. the second layer is rolled toward the first layer to contact the first and second layers)."

The Office Action further required a species election between "Species A (appears to be claims 2, 6, [sic.] 9, 11), drawn to overlapping the first and second layers"¹ and "Species B (appears to be claims 3-5 and 10), drawn to contacting an edge of the first layer to an edge of the second layer."

In response to the restriction/election requirement, Applicant provisionally elects Group I (claims 1-14) and Species A for prosecution in this application, with the understanding that the claims shall be so restricted only if no claim that is generic to other species is finally held to be allowable. Applicant reserves the right to file divisional applications to protect the inventions of the non-elected Group and Species in the application. It is believed that pending claims 1, 2, 6-9, and 11-14 are readable on the elected species.

¹ Because claims 1, 2, 6-9, and 11-14 were examined in the Office Action, Applicant believes that the proposed listing of claims for Species A was incomplete because it does not indicate claims 6 through 9 and because Species B does not include claims 6 through 9.

Traversal with respect to Species A and B. With respect to the required species election between Species A and B, Applicant traverses this requirement to the extent that Applicant believes the classifications of the inventions in Species A and B are the same and the field of search is the same.

The Office Action fails to demonstrate either separate classification or a different field of search with respect to Species A and B. Nor does the Office Action show a separate status in the art even if the species are classifiable together.

Thus, Applicant believes that dividing among these species is improper. *See* M.P.E.P. § 808.02. As such, Applicant believes that the alleged species of “overlapping the first and second layers” and “contacting an edge of the first layer to an edge of the second layer” should all be prosecuted in the present application.

The Office Action completely fails to identify what features distinguish the alleged Species A and Species B so as to require a species election. According to M.P.E.P. § 803, “Examiners must provide reasons and/or examples to support conclusions” for restriction requirements. The Office Action fails to provide any explanation of separate classification, or separate status in the art, or a different field of search for the alleged Species A and B. *See, e.g.,* M.P.E.P. § 803.

Applicants want to clearly indicate on the record that, at the least, the pending claims should *not* be restricted to either Species A or B, as the Office Action has not set forth proper grounds for a species restriction.

Traversal of election/restriction requirement in general. As stated in M.P.E.P. § 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Applicant submits that the search burden is not so great that restriction should be required between Groups I and II and election should be required with respect to Species A and B. Applicant believes that Groups I and II as well as Species A and B should all be prosecuted in the present application.

Thus, Applicant respectfully requests that the Examiner reconsider and vacate the election/restrictions requirement. If necessary, Applicant respectfully requests a personal or telephonic interview to discuss any remaining issues concerning the election/restrictions requirement.

Rejection Under 35 U.S.C. § 112, ¶ 2

Claims 1-2, 6-9, and 11-14 were rejected in the Office Action under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that “it is unclear what Applicant means by ‘rolling’” and that “the Examiner finds such language to be confusing and misleading.” Applicant respectfully traverses this rejection.

The Office Action acknowledges that “the specification also uses the term ‘rolling’ to describe the movement of the first layer toward the second layer.” In fact, the terms “rolling”, “rolled”, and “roll” are used repeatedly throughout the specification, for example:

- “a rolling/fusing stage” – page 8, line 8;
- “a step of rolling at least one of the upper and lower layers toward the other layer” – page 8, lines 21-22;
- “the tab 6 is bent or rolled” – page 9, lines 28-29;
- “tab 6 can be heated to make it pliable before it is rolled” – page 9, lines 30-31;
- “second section 12b has a guide surface that is contoured or arcuated to guide and roll the tab 6 toward the upper layer while either the panel 1 or the apparatus 100 is moved relative to the other” – page 10, lines 4-7;
- “[t]o more easily roll or bend the tab 6, the bending stage 10 can include a heater 14” – page 10, lines 16-17;
- “the method can include rolling, folding, or moving both the upper and lower layers toward one another” – page 13, lines 10-11;
- “[a]fter heating, the layers are further rolled, folded, or moved so that they contact and fuse” – page 13, lines 13-14;
- “the guides starts to bend or roll the tabs” – page 13, line 23;
- “the method can include rolling, folding, or moving at least one of the upper and lower layers 2, 3 toward the other” – page 14, lines 9-11;
- “both the upper and lower layers 2, 3, can be rolled, folded, or moved toward one another” – page 14, lines 14-15;
- “the guides starts to bend or roll the tabs” – page 14, line 24; and
- “[e]ither one or both of the layers can be heated and rolled toward the other layer” – page 20, line 9.

It is beyond dispute that “inventors may be their own lexicographers” and that “they must use words in the same way in the claims and in the specification.” *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632 (Fed. Cir. 1987). Applicant submits that use of the term “rolling” with respect to claims 1-2, 6-9, and 11-14 is not only consistent with its use in the specification but is neither confusing nor misleading. The specification provides clear support and antecedent basis for this term.

The Office Action states that “one reading the specification as a whole would appreciate that a roller is never used in any of the various embodiments to move the first layer toward the second layer and/or the second layer toward the first layer.” However,

Applicant submits that the specification does for example disclose an embodiment in which "second section 12b has a guide surface that is contoured or arcuated to guide and roll the tab 6." (Specification, page 10, lines 4-5). The specification further discloses an embodiment in which "the guides starts to bend or roll the tabs." (*Id.*, page 14, line 24). Thus, the claim term "rolling" is proper and understandable in view of the intrinsic evidence.

Withdrawal of the rejection under 35 U.S.C. § 112, second paragraph respectfully is requested.

Rejections Under 35 U.S.C. § 102(b)

In the Office Action, claims 1-2 and 7-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,347,955 to Kamal ("Kamal"). The rejection respectfully is overcome.

Kamal is directed to a reversed moving die folding and creasing machine and describes a lining fabric 26 and a facing fabric 25 that are inserted into a punch cavity 19. (Kamal, Col. 3, lines 40-41). As understood, Kamal is unrelated to a ribbed thermoplastic panel.

Claims 1-2, 6-8, and 11 were rejected in the Office Action under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,201,609 to Òlsén ("Òlsén"). The rejection respectfully is overcome.

Òlsén is directed to a method for T or butt sealing of laminated all-plastic material. Two sheets of a laminated thermoplastic material are joined by hot air heating which causes the edge portion of a central layer to soften and retract followed by softening of the edge portions of facing layers which then turn inwardly and join together thus closing off the central layer. (Òlsén, Abstract). As understood, Òlsén is unrelated to a ribbed thermoplastic panel. Also, Òlsén is silent with respect to, *inter alia*, rolling at least the first layer along a surface toward the second layer and contacting the first layer with the second layer.

Claims 1-2 and 6-8 were rejected in the Office Action under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,356,053 to LoMaglio ("LoMaglio"). The rejection respectfully is overcome.

LoMaglio is directed to edge sealing of laminates. As understood, LoMaglio is unrelated to a ribbed thermoplastic panel.

Claims 1-2, 6-8 and 13-14 were rejected in the Office Action under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,507,348 to Nagata *et al.* ("Nagata"). The rejection respectfully is traversed.

The Office Action states that "Nagata teaches closing an open end of a product." The Office Action makes reference, *inter alia*, to Figures 2 and 10 thereof. Nagata discloses that a corrugated sheet is provided with a flute portion that has a hinge effect. (Nagata, Col. 2, lines 18-19). Bending portion 5 shown in FIG. 2 and flute portion 14 shown in FIG. 10 enable bending. (*Id.*, Col. 4, lines 7-8, 34-35). In other words, flap portion 4 is capable of being bent through portion 5 connected thereto. (*Id.*, Col. 2, lines 61-63). Thus, as understood, Nagata is completely unrelated to closing an open end of a product.

Claims 1-2, 6-8, and 11 were rejected in the Office Action under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,929,536 to Maughan ("Maughan"). The rejection respectfully is overcome.

Maughan is directed to a moisture resistant corner post for use in conjunction with containers. (Maughan, Col. 1, lines 1-10). Maughan discloses that a corner post is completely enclosed in a plastic film and sealed on all sides, protected from moisture penetration. (*Id.*, Col. 2, lines 28-30). A corrugated paperboard blank is used to fabricate the corner post. (*Id.*, Col. 3, lines 21-22). Referring to FIG. 4, a corner post is simultaneously encased in upper and lower films, side seams are formed, end closure is effected, and the entire post is passed through a heated zone which shrink wraps the plastic film around the corner post. (*Id.*, Col. 6, lines 29-33). As understood, Maughan is completely unrelated to a ribbed thermoplastic panel as claimed in independent claim 1. The plastic films of Maughan are distinct from the corrugated paperboard blank; in particular, the plastic film sheets are the components joined at a seam 55. (*Id.*, Col. 5, line 15). In contrast, in pending claim 1, portions of the panel are subjected to the rolling and fusing steps.

Finally, in the Office Action claims 1-2, 7-8, and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,069,738 to Ruemeli *et al.* ("Ruemeli"). The rejection respectfully is overcome.

Ruemeli is directed to a process and device for applying a protective film to an alveolated board. A film 7 of flexible material is applied to one of the surfaces along the longest dimensions of the board, whose length is sufficient to form at least one fold 71 covering one of the ends. (Ruemeli, Col. 2, lines 32-36). The fold can be provided with a tab 72 enabling it to be coupled to film 8 covering the other surface of the board. (*Id.*, Col. 2, lines 36-38). The tab can be affixed by any method, gluing or welding. (*Id.*, Col. 2, lines 39-40). As understood, Ruemeli is completely unrelated to a ribbed thermoplastic panel as claimed in independent claim 1. The films of Ruemeli are distinct from the board; in particular, films 7, 8 are the components that are contacted. (*Id.*, Col. 5, line 16). In contrast, in pending claim 1, portions of the panel are subjected to the rolling and fusing steps.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-2, 7-9, and 13-14 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,630,806 to Kitajima *et al.* ("Kitajima") in view of the collective teachings of U.S. Patent No. 3,579,396 to Washburn *et al.* ("Washburn"), U.S. Patent No. 3,616,077 to Jessee *et al.* ("Jessee"), U.S. Patent No. 3,031,356 to Bousquet *et al.* ("Bousquet"), U.S. Patent No. 4,606,784 to Glans *et al.* ("Glans"), U.S. Statutory Invention Registration No. H556 to Tarko ("Tarko"), and Ruemeli. The rejection respectfully is traversed.

With respect to Kitajima, the Office Action states that "[t]he reference is silent as to rolling at least the first layer toward the second layer and contacting the first layer with the second layer and fusing the first and second layers by heating at least one portion of the first layer that contacts the second layer and a portion of the second layer that contacts the first layer." The Office Action continues that with respect to Washburn, Jessee, and Bousquet, "it is appreciated that all of these references use adhesive to bond the facing sheets to each other." But the Office Action relies on Glans, Tarko, and Ruemeli as showing that "fusing the layers to close the open ends eliminates having to use a separate bonding material, i.e. adhesive."

The Office Action fails to identify any suggestion to combine Kitajima, Washburn, Jessee, Bousquet, Glans, Tarko, and Ruemeli to arrive at the claimed inventions. "[I]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051 (Fed. Cir. 1988) (citations omitted). "When prior art references require

selective combination . . . to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.” *Id.* (citations omitted).

Kitajima appears to be cited in the Office Action solely for its disclosure of a corrugated composite sheet.

With respect to Washburn, Jessee, and Bousquet, these references teach away from the invention of independent claim 1. As the Office Action states, “these references use adhesive to bond the facing sheets to each other.” Applicant’s specification specifically distinguishes the present invention from prior art constructions that rely on the use of bonding agents.

Glans and Tarko, for example, are understood to be unrelated to a ribbed thermoplastic panel.

And with respect to Ruemeli, the films disclosed therein are distinct from the board; in particular, films 7, 8 are the components that are contacted. (Ruemeli, Col. 5, line 16).

Thus, Applicant submits that there is no teaching or suggestion in any of the references, or in the cited prior art as a whole, that would lead one of ordinary skill in the art to make the combination of Kitajima, Washburn, Jessee, Bousquet, Glans, Tarko, and Ruemeli. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

In the Office Action, claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamal. Claim 9 also was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagata in view of the collective teachings of Washburn, Jessee, and Bousquet.

Claim 11 was rejected under 35 U.S.C. § 103(u) as being unpatentable over LoMaglio in view of Olsen. Claim 11 also was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagata in view of Olsen.

Claim 12 was rejected under 35 U.S.C. § 103(u) as being unpatentable over Kamal in view of U.S. Patent No. 5,246,516 to Rias. Claim 12 also was rejected under 35 U.S.C. § 103(a) as being unpatentable over Olsen or LoMaglio or Maughan. Claim 12 further was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagata in view of

Rias. Claim 12 further was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruemeli in view of Rias. In addition, claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kitajima in view of the collective teachings of Washburn, Jessee, Bousquet, Glans, Tarko, Ruemeli, and Rias.

And, claims 6 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kitajima in view of the collective teachings of Washburn, Jessee, Bousquet, Glans, Tarko, Ruemeli, U.S. Patent No. 3,785,908 to Wagers *et al.*, and U.S. Patent No. 5,545,279 to Hall *et al.*


It is submitted that dependent claims 6, 9, 11, and 12 at least are patentable not only because of the patentability of the independent claim from which they depend, but also for the totality of features recited respectively therein.

In view of the foregoing, it is believed that all the pending claims are in condition for allowance, which is respectfully requested. If the Examiner does not agree, then a personal or telephonic interview is respectfully requested to discuss any remaining issues so as to expedite the eventual allowance of the claims.

A Fee Transmittal Sheet is attached for the presentation of new claims. Should any additional fees be required, please charge all required fees to Steptoe & Johnson LLP Deposit Account No. 19-4293.

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Respectfully Submitted,



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Attachment